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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,580	01/23/2004	John Carney	40004572-0023-002	7727
26263 7590 07/09/2008 SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080				
EXAMINER PARRA, OMAR S				
ART UNIT 2623		PAPER NUMBER		
NOTIFICATION DATE 07/09/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@sonnenschein.com

### Office Action Summary

**Application No.**

10/763,580

**Applicant(s)**

CARNEY ET AL.

**Examiner**

OMAR PARRA

**Art Unit**

2623

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-13, 15-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-13, 15-23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 04/11/2008 have been fully considered but they are not persuasive.

In response to applicant's arguments:

Applicant argues that *'neither reference [Begeja or Holtz] teaches providing a list of one or more VOD clip attributes, each of the VOD clip attributes pertaining to a subset of the one or more VOD clips corresponding to a VOD clip category'*, (Remarks: page 9 second paragraph). To this matter the examiner respectfully disagrees.

Holtz teaches a system that collects video clips from different sources about a user-specified topic, puts them together as a single program and sends it to the user for viewing (Abstract; col. 16 line 3- col. 17 line 5). Holtz also teaches that the user is able to specify the topic of the video clips from a general topic down to 2 or 3 levels of specificity (i.e. a topic, a category within a topic, a sub-category within a category, col. 13 lines 3-39; col. 17 lines 1-5; col. 31 lines 27-56). The user is provided with a drop-down menu (listing) or a sequence of dialog boxes (e.g. wizard) to narrow his/hers selection topic. Given the multiple options for selecting a topic, an inherent listing of the selection options is needed.

Therefore, the examiner respectfully believes that the art of record still covers applicant's invention as claimed and maintains the previous rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims **1-2, 4-13, 15-23 and 25-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Begeja et al. (hereinafter 'Begeja', Pub. No. US 2003/0030752) in view of Holtz et al. (hereinafter 'Holtz', Patent No. 6,760,916).

Regarding **claims 1, 12 and 22**, Begeja teaches a system (with corresponding method and computer-readable medium) comprising:

a server ("Video Server", 220 Fig.2, or "Video Storage", 210 Fig.2, if more storage is needed) storing VOD content ([0031] lines 1-2), the VOD content including a plurality of VOD clip categories ([0051] lines 3-4), each VOD clip category containing one or more corresponding VOD clips ([0051] lines 4-5); and

a set top box (370, Fig.3) coupled to the server (220, Fig.3), the set top box storing an application ([0058] lines 4-5 or [0015] paragraph-lines 2-5 of incorporated by reference application, Begeja Pub. No. 2003/0163815), the application including VOD clip category selection functionality ([0054] lines 3-4. Having a list of topics determined by a profile implies that there was a functionality that lets to choose the topics at the creation of the profile) that enables a user to access the plurality of VOD clip categories

and select one or more VOD clip categories, ([0051] lines 3-4), a VOD clip parameter selection functionality (Buttons, Drop-down menus and check boxes, Fig. 4-5) that allows a user to select one or more VOD clip parameters ([0066] lines 9-10), each of the VOD clip parameters pertaining to a subset of the one or more VOD clips (505, Fig.5) corresponding to a VOD clip category (565, Fig.5) such that the created composite VOD clip consists of the subset of the one or more VOD clips corresponding to each selected VOD clip category ("When one or more of these clips (referring to clips in 505, Fig.5) is chosen for viewing by the user, that clip is shown in section 510" (Fig.5, playing area of the composite video) [0064] lines 1-2); and a VOD clip composite functionality that automatically creates a composite VOD clip ([0028] ¶ lines 1-3) wherein the composite VOD clip consists of each of the one or more corresponding VOD clips of each selected VOD clip category ([0059] lines 9-10 or see 405, Fig.4);

On the other hand, Begeja does not explicitly teach a VOD clip attribute selection functionality that allows a user to select one or more VOD clip attributes, each of the VOD clip attributes pertaining to a subset of the one or more VOD clips corresponding to a VOD clip category such that the created composite VOD clip consists of the subset of the one or more VOD clips corresponding to each selected VOD clip category.

However, in an analogous art, Holtz teaches a VOD multimedia production and distribution system that assembles a media production from a variety of sources based on personal preferences (Abstract). Holtz teaches that for setting the user preferences or the type of content he/she wants, a VOD clips attribute selection functionality is presented to him/her in order to let the system know what categories are desired, how

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long he/she wants the production or clips to be, etc (col. 13 lines 3-31; col. 16 line 4-col. 17 line 5; col. 31 line 18-col. 32 line 64).

Therefore, it would have been obvious to an ordinary skilled in the art at the time of the invention to have modified Begeja's invention with Holtz's feature of letting the user to define video clips attributes through an interface for the benefit of providing to the user a neat, easy to fill up interface for customizing the video clips or content to be received.

Regarding **claim 2**, the combined teachings of Begeja and Holtz teaches a method comprising:

presenting the composite VOD clip to a user to effect a passive viewing experience ([0053] lines 19-20).

Regarding **claim 4**, the combined teachings of Begeja and Holtz teaches a method comprising:

receiving further user input, the further user input specifying at least one of the one or more VOD clip parameters ([0066] paragraph lines 9-10), wherein the composite VOD clip consists of the subset of the one or more VOD clips (505, Fig.5) corresponding to the selected VOD clip parameters in each specified VOD clip category (565, Fig.5).

Regarding **claim 5**, the combined teachings of Begeja and Holtz teaches a method wherein the one or more VOD clip parameters includes a VOD clip parameter selected from the group consisting of a random selection parameter (420, Fig.4, "Play all clips" without knowing what's going to play is a random selection), a maximum number parameter, a maximum time parameter (505, Fig.5, by checking the check boxes users are able to choose the maximum time and maximum number of clips for his composite video clip), and a sequential parameter ([0065] lines 2-4).

Regarding **claim 6**, the combined teachings of Begeja and Holtz et al teaches a method wherein the composite VOD clip is automatically regenerated ([0026] lines 7-10) upon user request ("instant search", [0058], paragraph-line 2) or according to an externally specified schedule ("...on a periodic basis..."[0026], line 9).

Regarding **claim 7**, the combined teachings of Begeja and Holtz teaches a method wherein the one or more corresponding VOD clips made available prior to a specified time (405, Fig.4, videos are available prior user's selection) are removed ("AT&T, 8 clips", "Jay Lenos White H... 10 clips", "Sports, 6 clips", see Fig.4, are removed after choosing "Politics") from the composite VOD clip (505, Fig.5).

Regarding **claim 8**, the combined teachings of Begeja and Holtz et al teaches a method wherein the one or more corresponding VOD clips previously presented to a particular user (405, Fig.4, videos are presented to the user for selection) are removed

("AT&T, 8 clips", "Jay Lenos White H... 10 clips", "Sports, 6 clips", see Fig.4, are removed after choosing "Politics") from the user's composite VOD clip (505, Fig.5).

Regarding **claim 9**, the combined teachings of Begeja and Holtz teaches a method wherein one or more additional VOD clips are included as component VOD clips of the composite VOD clip ("The user can add a new topic using button 425, Fig.4" [0062] paragraph line 3, which inherently would add more clips to the composite video).

Regarding **claim 10**, the combined teachings of Begeja and Holtz et al teaches a method wherein the one or more additional VOD clips is a VOD clip selected from the group consisting of advertising VOD clips ( [0057] lines 19-21), promotional VOD clips pertaining to VOD content unrelated to the composite VOD clip ("Additional marketing and advertising (such as a commercial...)", [0057] paragraph lines 19-20), and promotional VOD clips pertaining to VOD content related to the composite VOD clip ("Relevant information that might be embedded into a media stream being delivered...might include...information about the subject matter of the stream or related thereto, such as advertising...", [0087] paragraph lines 1-4).

Regarding **claim 11**, the combined teachings of Begeja and Holtz et al teaches a method wherein one or more additional graphical or data contents, including content tickers, graphical ads or promotional contents unrelated to the composite VOD clip, and content tickers, graphical ads or promotional contents related to the composite VOD clip



([0087] paragraph lines 5-7 or also, 555, Fig.5) are added alongside or partially overlay the composite VOD clip.

Regarding **claim 13**, the combined teachings of Begeja and Holtz teaches a method comprising:

presenting the composite VOD clip to a user to effect a passive viewing experience ([0053] lines 19-20).

Regarding **claim 15**, the combined teachings of Begeja and Holtz teaches a method further comprising:

receiving further user input, the further user input specifying at least one of the one or more VOD clip parameters ("With buttons 560 and 565,"-referring to Fig.5- "a user may clear or select all of the clips being shown within a particular topic.", [0066] paragraph lines 9-10), wherein the composite VOD clip consists of the subset of the one or more VOD clips (505, Fig.5) corresponding to the selected VOD clip parameters in each specified VOD clip category (565, Fig.5).

Regarding **claim 16**, the combined teachings of Begeja and Holtz teaches a method wherein the one or more VOD clip parameters includes a VOD clip parameter selected from the group consisting of a random selection parameter (420, Fig.4, "Play all clips" without knowing what's going to play is a random selection), a maximum number parameter, a maximum time parameter (505, Fig.5, by checking the check

boxes users choose the maximum time and maximum number of clips for their composite video clip), and a sequential parameter (“...page 500 will play all the clips in a predetermined order (e.g. reverse chronological order, by source of content, etc”, [0065] lines 2-4).

Regarding **claim 17**, the combined teachings of Begeja and Holtz teaches having the composite VOD clip is automatically regenerated ( [0026] lines 7-10) upon user request (“instant search”, [0058], paragraph-line 2) or according to an externally specified schedule (“...on a periodic basis...”, paragraph [0026] line 9).

Regarding **claim 18**, the combined teachings of Begeja and Holtz teaches having the one or more corresponding VOD clips made available prior to a specified time (405, Fig.4, videos are available prior user’s selection) are removed (“AT&T, 8 clips”, “Jay Lenos White H... 10 clips”, “Sports, 6 clips”, see Fig.4, are removed after choosing “Politics”) from the composite VOD clip (505, Fig.5).

Regarding **claim 19**, the combined teachings of Begeja and Holtz teaches having the one or more corresponding VOD clips previously presented to a particular user (405, Fig.4, videos are presented to the user for selection) are removed (“AT&T, 8 clips”, “Jay Lenos White H... 10 clips”, “Sports, 6 clips”, see Fig.4, are removed after choosing “Politics”) from the user’s composite VOD clip (505, Fig.5).

Regarding **claim 20**, the combined teachings of Begeja and Holtz teaches having one or more additional VOD clips are included as component VOD clips of the composite VOD clip ("The user can add a new topic using button 425, Fig.4" [0062] paragraph-line 3, which, according to the invention, inherently would add more clips to the composite video).

Regarding **claim 21**, the combined teachings of Begeja and Holtz teaches having the one or more additional VOD clips is a VOD clip selected from the group consisting of advertising VOD clips ([0057] lines 19-21), promotional VOD clips pertaining to VOD content unrelated to the composite VOD clip ([0057] lines 19-20), and promotional VOD clips pertaining to VOD content related to the composite VOD clip ([0087] paragraph lines 1-4).

Regarding **claims 23**, the combined teachings of Begeja and Holtz teaches a system further comprising:

a display screen (380, Fig.3) for presenting the composite VOD clip to the user to effect a passive viewing experience.

Regarding **claim 25**, the combined teachings of Begeja and Holtz teaches a system wherein the one or more VOD clip parameters includes a VOD clip parameter selected from the group consisting of a random selection parameter (420, Fig.4, "Play all clips" without knowing what's going to play is a random selection), a maximum

number parameter, a maximum time parameter (505, Fig.5, by checking the check boxes users choose the maximum time and maximum number of clips for their composite video clip), and a sequential parameter ([0065] lines 2-4).

Regarding **claim 26**, the combined teachings of Begeja and Holtz teaches having a system wherein the composite VOD clip is automatically regenerated ([0026] paragraph-lines 7-10) upon user request ("instant search", [0058], line 2) or according to an externally specified schedule ("...on a periodic basis...", paragraph [0026] line 9).

Regarding **claim 27**, the combined teachings of Begeja and Holtz teaches having a system the one or more corresponding VOD clips made available prior to a specified time (405, Fig.4, videos are available prior user's selection) are removed ("AT&T, 8 clips", "Jay Lenos White H... 10 clips", "Sports, 6 clips", see Fig.4, are removed after choosing "Politics") from the composite VOD clip (505, Fig.5).

Regarding **claim 28**, the combined teachings of Begeja and Holtz teaches having a system wherein the one or more corresponding VOD clips previously presented (405, Fig.4, videos are presented to the user for selection) to a particular user are removed ("AT&T, 8 clips", "Jay Lenos White H... 10 clips", "Sports, 6 clips", see Fig.4, are removed after choosing "Politics") from the user's composite VOD clip (505, Fig.5).

Regarding **claim 29**, the combined teachings of Begeja and Holtz teaches having a system wherein one or more additional VOD clips are included as component VOD clips of the composite VOD clip ("The user can add a new topic using button 425, Fig.4" [0062] paragraph-line 3, which inherently would add more clips to the composite video).

Regarding **claim 30**, the combined teachings of Begeja and Holtz teaches having a system wherein the one or more additional VOD clips is a VOD clip selected from the group consisting of advertising VOD clips ([0057] lines 19-21), promotional VOD clips pertaining to VOD content unrelated to the composite VOD clip [0057] lines 19-20), and promotional VOD clips pertaining to VOD content related to the composite VOD clip ([0087] paragraph lines 1-4).

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMAR PARRA whose telephone number is (571)270-1449. The examiner can normally be reached on 9-6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OP

/Christopher Grant/  
Supervisory Patent Examiner, Art Unit 2623